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| 10/813,587 | 03/31/2004 | David Stein | 2006P26235 US | 4314 |

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SIEMENS CORPORATION
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| EXAMINER |
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TURK, NEIL N

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| ART UNIT | PAPER NUMBER |
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1797

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04/16/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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| Office Action Summary | Application No. 10/813,587 | Applicant(s) STEIN ET AL. | |
| | Examiner NEIL TURK | Art Unit 1797 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 3/31/04 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Remarks

This Office Action fully acknowledges Applicant's remarks filed on January 16th, 2008. Claims 1-20 are pending. Claims 13-20 were previously withdrawn from consideration. Claims 13-20 are herein rejoined (as per Applicant's amendment) in the application, and claims 1-20 will be prosecuted on the merits. Any objection/rejection not repeated herein has been withdrawn by the Office.

Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The specification does not provide proper antecedent basis for the various "means for" limitations recited throughout claims 1-12.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims invoke 35 U.S.C 112, sixth paragraph, in several instances with use of "means for" language, however the specification does not

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provide support for the “means for” language used in the claims. For example, claim 1 recites “means for loading”, “means for identifying”, and “means for moving”. The specification does not generally recite any of the above “means for” phrases, nor does it provide for any specific structure that corresponds to any of the above “means for” phrases, as well as the other “means for” recitations throughout dependent claims 3-5.

Further, this interpretation is proper since the claim limitation recites “means for” language, and the “means for” is not modified by sufficient structure for achieving the specified function. A means-plus-function limitation recites a function to be performed rather than definite structure or materials for performing that function. For claims falling under 35 U.S.C. 112, sixth paragraph, Examiners are required to construe claims as covering the corresponding structure, material, or acts described in the specification and equivalents thereof, see *In re Donaldson Co.*, 29 USPQ2d 1845 (Fed. Cir. 1994). However, the specification does not set forth the corresponding structure. Thus, it is unclear and indefinite what structure Applicant is intending to encompass with the “means for” limitations recited throughout claims 1 and 3-5.

Claims 2 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 2 recites that the controller determines an optimized launch of test sequence for each sample based on any samples currently under test and any sample yet to be tested. It is unclear what constitutes an “optimized” launch of test sequence. Claim 2 currently recites that it is based on any samples

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currently under test and any samples yet to be tested. Such a recitation covers all samples and provides no clarification to the optimized launch of test sequence. Further, it is unclear how the controller determines a launch of test sequence for a sample that is already under test, and how a time and order for the tests to be launched is achieved with samples that are already under test. The claim language to the controller's determination of a launch of test sequence is unclear with respect to the two types of samples. How does the controller determine an optimized launch of test sequence for the samples? Additionally, the phrase "a launch of test sequence" is unclear. Does Applicant intend to recite, "a launch of a test sequence" or "a launch of test sequences"? This is similarly seen in claim 14, absent the term "optimized".

Claims 13-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear what is meant by, "moving each of said plurality of test vessels along its respective path determined in said using a computer controller to determine step". The step is recited in an unclear and confusing manner. Does Applicant intend for this step to merely to be a step of actual movement according to the path determined? Does Applicant intend some other control of movement? Clarification is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Hanawa et al. (5,972,295), hereafter Hanawa.

Hanawa discloses an automatic analyzing apparatus. Hanawa discloses a tray having many aligned sample racks 2 is loaded in a rack supply unit 1 (lines 22-30, col. 4, fig. 1). Hanawa also discloses a transfer line 3 that is composed of a belt line rotating upward and downward, and the transfer operation is controlled so that the sample rack stops at predetermined positions. Hanawa also discloses that the rack identifying unit 4 has a bar-code reader 5 for identifying a destination of the sample rack that comes to the entrance of the transfer line. Hanawa further discloses that the identifying apparatus may also be provided at the analyzing units 6, 14 or at the exit of the transfer line in addition to being at the rack identifying unit. Hanawa further discloses that the content of the bar-code label 87 of the rack and the bar-code label 86 of the sample containers are transferred to a control unit 50, and the rack kind, the kind of analysis item instructed to each of the sample containers, and other information is compared with analysis information pre-instructed from an operating unit 55. Based on the compared results, the destination of the sample rack 2 is determined by the control unit 50 and stored in memory for processing of the sample rack to be performed later (lines

38-60, col. 4, fig. 1). Hanawa discloses that the analyzer units 6 or 14 along the transfer line comprise a sampling area 8 or 16 for receiving a sample rack and returning the sample rack after pipetting processing (lines 8-27, col. 5, fig. 1). Hanawa further discloses that the control unit 50 judges whether or not the sample racks require analysis of a particular analyzer (or of an additional analyzer if previously analyzed at analyzer 6) or if a sample rack is to be returned for additional analysis (or reexamination), and the rack is directed along the appropriate path(s) as judged by the control unit in each case (columns 5&6, fig. 1).

Response to Arguments

Applicant's arguments filed January 16th, 2008 have been fully considered but they are not persuasive.

With regards to claims 1-12 rejected under 35 USC 112, 2nd paragraph, Applicant traverses the rejection. Applicant argues that the use of the "means for language" in claims 1 and 3-5 does not violate 35 USC 112, 2nd paragraph. Examiner argues that the claims are indefinite as the "means for" language is not modified by sufficient structure for achieving the function and the specification does not provide antecedent basis for such "means for" language. It is thereby unclear what structure is involved for carrying out the intended functions. Applicant may amend the specification in the cited portions (as noted in Applicant's remarks on page 7 of 9) to include a

disclosure that establishes that such structure corresponds to the various "means for" limitations. Applicant may also amend the claims to remove the "means for" limitations and add the actual structural elements that have basis in the specification for achieving such functions.

With regards to claim 2 rejected under 35 USC 112, 2nd paragraph, Applicant traverses the rejection. The rejection is maintained as discussed above, and the amendment to add the term "optimized" introduces further lack of clarity in the claim.

With regards to claims 1-12 rejected under 35 USC 102(b) as being anticipated by Hanawa (5,972,295), Applicant traverses the rejection.

Applicant argues that Hanawa does not show a means for identifying tests to be performed. Examiner argues that each sample container has a bar-code label 86, which acts as a means for identifying tests to be performed, as the information that is read identifies the rack kind and the kind of analysis item instructed to each sample container, so that the read information provides for where and for what analyses, samplings, or other transfers occur with each sample container (lines 31-60, col. 4, for example). Examiner further argues that Hanawa discloses a plurality of resources that perform specified functions on the sample containers, such as a sampling area 8, pipetting mechanism 9, and rack ejection mechanism 13.

Applicant further argues that Hanawa does not show that each of the tests is to be performed in a test vessel. Examiner argues that the test vessels are not positively recited elements in the claims, and thereby the recitation to the tests being performed in

a test vessel is a recitation that is drawn to an intended use that is not afforded patentable weight. The claims recite means for loading one or more samples into one or more test vessels. This recitation points to a structure for loading and the proceeding recitation is a capability of such structure and does not positively establish the elements as part of the device. Thereby, as the prior art of Hanawa discloses means for loading samples, it is said to be capable of the recited function.

Applicant further argues that Hanawa does not show a computer controller which tracks the location of each test vessel. Examiner asserts that, as discussed above, the test vessels have not been positively established as elements of the device, and thereby Applicant has recited a computer controller. Examiner further argues that the Hanawa discloses a computer controller and thereby such controller is capable of such functionalities. Examiner further asserts that Hanawa discloses that control unit 50 tracks the locations and controls movement of the sample containers (and sample racks, where the sample containers are located) through the conveyors and transfer/take-up mechanisms and determines paths between the resources (i.e. further analysis units, pipetting mechanisms, return lines, etc...that are down the line in the process) for the sample containers based on the tests identified to be carried out and the results of each subsequent test(cols. 4-7, figure 1, for example).

Claims 13-20 have been rejoined in the case in view of Applicant's amendment to the claims, such that the method cannot be performed by another materially different apparatus or by hand, as reported by Applicant.

Claims 13-20 are rejected as discussed above for the first time on the merits and such grounds of rejection is established as necessitated by Applicant's amendments to claims 13-20.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NEIL TURK whose telephone number is (571)272-8914. The examiner can normally be reached on M-F, 9-630.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

NT

/Jill Warden/
Supervisory Patent Examiner, Art Unit 1797